

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 09/667,779
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REMARKS

Applicants thank the Patent Office for initialing the references listed on the PTO-1449 form submitted with the Information Disclosure Statement filed on September 22, 2000, thereby confirming that the listed references have been considered.

Applicants herein editorially amend claim 1 to remove grammatical errors. The amendments to claim 1 were not made for reasons of patentability, do not narrow the literal scope of the claim and do not implicate an estoppel in the application of the doctrine of equivalents.

Claims 1-12 have been examined on their merits, and are all the claims pending in the application.

1. Claim 10 stands rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants herein amend claim 10 to recite that the computer program product is embodied on a computer readable medium. Applicants submit that the § 101 rejection of claim 10 has been overcome, and respectfully request withdrawal of same.
2. Claims 1, 2, 11 and 12 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Neilsen (U.S. Patent No. 5,870,548). Applicants traverse the rejection of claims 1, 2, 11 and 12 for at least the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies*,

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Inc., 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). A proper anticipation rejection requires that every element of the claim be found “in a single prior art reference.” *See In re Robertston*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999). For anticipation to exist, there must be no difference between the claimed invention and the reference disclosure, as that reference would be understood by one of ordinary skill in the art. *See Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); *see also, Crown Operations Intn’l, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 U.S.P.Q.2d 1917 (Fed. Cir. 2002). Further, “an anticipating reference must describe the [claimed] subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention.” *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 545, 48 U.S.P.Q.2d 1321, 1328 (Fed. Cir. 1998) (citing *In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

With respect to claim 1, Nielsen fails to teach or suggest routing a modification message that modifies a body of a sent e-mail to a server where the sent e-mail is stored and modifying the body of the sent e-mail if a plurality of addressees have not accessed the e-mail body, wherein the server modifies the e-mail body apart from any e-mail processing means associated with each addressee. While the Patent Office has previously cited col. 15, line 40 to col. 16, line 60 and Figure 11A of Nielsen as allegedly disclosing the modification of the e-mail body prior to its being viewed by any addressees, the cited passages and Figure disclose the modification of an e-mail body by the receiving e-mail system at the recipient's terminal¹, and not the modification of an e-mail body that is stored at a server that is operating independently from any e-mail processing means associated with the e-mail recipient. For example, step 1105 in Figure 11A discloses that the receiving e-mail system stores the received e-mail in the recipient's inbox. *See* col. 16, lines 9-11 of Nielsen; *see also*, col. 14, lines 49-58. Nielsen further discloses how the text of a received e-mail is modified while stored in the recipient's inbox. *See* col. 16, lines 13-25 of Nielsen. There is no teaching or suggestion in Nielsen, however, that the modification of the e-mail body stored in a recipient's inbox is controlled in any manner based on whether other recipients (*i.e.*, addressees) have viewed the e-mail body. The Patent Office alleges that Nielsen discloses this feature of the invention in Figure 8B and col. 12, lines 5-38. The Cancel DB Data Record (820) shown in Figure 4 has a Message Seen Before Cancel flag (823) that is set to false when the e-mail message is received, and is set to true if the recipient of the e-mail message

¹ "The processing starts at the terminal labeled as 1101 when the receiving e-mail system receives 1103 a message containing an X-Modify: header field." *See* col. 15, lines 47-49 of Nielsen.

views the e-mail message before a cancellation or modification request arrives. *See* col. 12, lines 35-38 of Neilsen. Unlike the present invention, the modification of the e-mail body is not dependent upon whether other recipients have viewed the e-mail body prior to the execution of the modification message on the independent server. There is no disclosure in Neilsen that the setting of the Message Seen Before Cancel flag (823) in the Cancel DB Data Record (820) is affected by other addressees of the same e-mail message, or is there any teaching or suggestion that the modification of the e-mail message body is prohibited if other addressees have accessed the stored e-mail message body.

In contrast to the invention recited in claim 1, Step 411 of Figure 4 of Neilsen is clear that the recipient's e-mail receiver program processes the e-mail message or modifies the e-mail message. *See also*, col. 7, lines 16-19 of Neilsen. The Patent Office's citation to col. 6, lines 44-67 of Neilsen does not apply to the invention recited in claim 1, in that it discusses a conventional e-mail system that does not allow for e-mail message modification subsequent to the sending of an e-mail message. Furthermore, the Patent Office's citation to col. 8, line 4 to col. 9, line 22 discusses how Neilsen's GUI interface operates; there is no teaching or suggestion, however, in the GUI description of prohibiting the modification of the e-mail message body if other addressees have accessed the stored e-mail message body.

Based on the foregoing reasons, Applicants submit that Neilsen fails to teach or suggest all of the claimed elements as arranged in claim 1. Therefore, under *Hybritech* and *Richardson*, Neilsen clearly cannot anticipate the present invention as recited in independent claim 1. Thus, Applicants submit that claim 1 is allowable, and further submit that claim 2 is allowable as well,

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at least by virtue of its dependency from claim 1. Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 1 and 2.

With respect to independent claim 11, Neilsen fails to teach or suggest a computer program product that modifies the body of a stored e-mail message addressed to a plurality of addressees as long as the plurality of addressees has not accessed the stored e-mail body, wherein the modification of the e-mail body occurs at a server independently of any e-mail processing means associated with each of the plurality of addressees. The reasons discussed above with respect to the rejection of claim 1 are equally applicable to the rejection of claim 11, in the Neilsen lacks any teaching or suggestion that the modification of the e-mail body is executed on the independent server as long as at least one of the plurality of addressees has not accessed the e-mail body stored on the independent server.

Based on the foregoing reasons, Applicants submit that Neilsen fails to disclose all of the claimed elements as arranged in claim 11. Therefore, under *Hybritech* and *Richardson*, Neilsen clearly cannot anticipate the present invention as recited in independent claim 11. Thus, Applicants submit that claim 11 is allowable, and further submit that claim 12 is allowable as well, at least by virtue of their dependency from claim 11. Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 11 and 12.

3. Claims 3-10 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Neilsen in view of Uchida *et al.* (U.S. Patent No. 6,237,610). Applicants traverse the rejection of claims 3-10 for at least the reasons discussed below.

The burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, as determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1208, 18 U.S.P.Q.2d 1016, 1022-23 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Alternatively, the

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motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.*

Regardless of whether the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697-98 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.* Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d at 1316-1317 (*citing B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996)); *see also, Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (B. Pat. App. & Inter. 1985)) (“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”).

With respect to independent claim 3, Neilsen fails to teach or suggest a server that operates independently from any e-mail processing means associated with a plurality of

addressees and comprises means for modifying the body of the sent e-mail if at least one of a plurality of addressees has not accessed the e-mail body stored on the server, wherein the modification is executed independently of any e-mail processing means associated with the plurality of addressees. Applicants' remarks above with respect to the rejection of claim 1 are equally applicable to the rejection of claim 3 over Neilsen and are incorporated by reference. Neilsen discloses that the e-mail recipient's terminal receives the modification message and the recipient's e-mail program modifies the message. There is no disclosure in Neilsen that the modification of the e-mail body is executed as long as the plurality of addressees has not accessed the e-mail body stored on the server. In fact, Neilsen discloses allowing the e-mail recipient to view the number of changes to the e-mail body, regardless of the number of addressees for that particular e-mail body. *See, e.g.*, col. 16, lines 26-60 of Neilsen. In sum, as noted above with respect to claim 1, the disclosure of Neilsen is limited to the modification of an e-mail body stored in a particular recipient's inbox, and, unlike the present invention, the modification of the e-mail body is not dependent upon whether other recipients have viewed the e-mail body prior to the execution of the modification message on the independent server.

The Patent Office acknowledges that Neilsen does not teach or suggest using an access code to access the e-mail body. The Patent Office alleges that Uchida *et al.* provides the necessary disclosure to overcome the acknowledged deficiencies of Neilsen. Applicants note that Uchida *et al.* was not cited as providing any additional disclosure with respect to the modification of a stored e-mail body.

The combination of Neilsen and Uchida *et al.* fails to teach or suggest a server that operates independently from any e-mail processing means associated with a plurality of addressees and comprises means for modifying the body of the sent e-mail if at least one of a plurality of addressees has not accessed the e-mail body stored on the server, wherein the modification is executed independently of any e-mail processing means associated with the plurality of addressees, as recited in claim 3. At best, the combination of Neilsen and Uchida *et al.* discloses that the e-mail recipient's terminal receives the modification message and the recipient's e-mail program modifies the message. There is no disclosure in the Neilsen and Uchida *et al.* that the modification of the e-mail body is executed as long as the plurality of addressees has not accessed the e-mail body stored on the server. In sum, the combination of Neilsen and Uchida *et al.* is limited to the modification of an e-mail body stored in a particular recipient's inbox, and, unlike the present invention, the modification of the e-mail body is not dependent upon whether other recipients have viewed the e-mail body prior to the execution of the modification message on the independent server. Thus, Applicants submit that the Patent Office cannot fulfill the "all limitations" prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Applicants submit that one of skill in the art would not be motivated to combine the two references. Although the Patent Office provides a motivation analysis with respect to an access code reducing network traffic, both Neilsen and Uchida *et al.* lack any teaching or suggestion about the desirability of a server that at least allows the modification of the body of the sent e-mail if at least one of a plurality of addressees has not accessed the e-mail body stored on the

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server, wherein the modification is executed independently of any e-mail processing means associated with the plurality of addressees. Applicants submit that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.


Based on the foregoing reasons, Applicants submit that the combination of Neilsen and Uchida *et al.* fails to disclose all of the claimed elements as arranged in claim 3. Therefore, the combination of Neilsen and Uchida *et al.* clearly cannot render the present invention obvious as recited in claim 3. Thus, Applicants submit that claim 3 is allowable, and that claims 4-10 are allowable as well, at least by virtue of their dependency from claim 3. Applicants respectfully request that the Patent Office withdraw the § 103(a) rejection of claims 3-10.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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